REMARKS

Claims 1-26 are pending in this application. No claims have been allowed. The Applicant withdrew claims 9-23 from further consideration in a Reply filed October 5, 2005. In the Office Action mailed December 14, 2005, the Examiner objected to claims 4 and 26 under 37 CFR § 1.75(c). The Examiner also rejected claims 1-8 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over the cited art of Suzuki (U.S. Patent No. 4,251,195), Suzuki (U.S. Patent Publication No. 2004/0051192), and Trail (U.S. Patent No. 5,383,776).

In this Response, the Applicant has amended the Specification at paragraphs [0020], [0022], [0026], [0033], [0044], [0045], and [0049] to correct minor typographical errors. The Applicant has amended claim 4 and cancelled claim 26. No new matter within the prohibition of 35 U.S.C. § 132 has been added. The Applicant kindly requests reconsideration and allowance of the pending claims for the reasons detailed below.

1) Objection to Claims 4 and 26:

The Examiner objected to claims 4 and 26 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to limit the subject matter of a previous claim. Specifically, the Examiner stated that these two claims fail to further limit the structure of the apparatus and instead refer to differences in the product worked upon by the apparatus of the claim.

In response to this objection, the Applicant has amended claim 4 to place it in proper dependent form and has cancelled claim 26. With regard to claim 4, the Applicant has amended its dependency to claim 1 rather than claim 3 and has added the words "microcapsule production unit" to provide proper antecedent basis for the further limitation of structure now given as a "dual-dispenser system configured to form co-axial multi-lamellar microspheres". The Applicant submits that amended dependent claim 4 now further limits the structure of the apparatus and asks the Examiner to withdraw the objection of this claim under 37 C.F.R. § 1.75(c).

2) Rejection under 35 U.S.C. 103:

The Examiner rejected claims 1-8 and 24-26 under 35 U.S.C. § 103 (a) as being unpatentable over Suzuki (U.S. Pat. No. 4,251,195) in view of Suzuki (U.S. Pat. Publication No. 20040051192) and Trail et al. (U.S. Pat. No. 5,383,776). Essentially, the Examiner concluded

that it would have been obvious to modify the teachings of Suzuki '195 and Suzuki '192 with that of Trail "to incorporate an analytic tool means to analyze the microspheres which are generally made of polymeric material in order to ensure quality and quantity production of the polymeric pellets as well as to operate the machine via a computer control system for collection and review of the data to determine optimal processing conditions."

In this Response, the Applicant first respectfully requests the Examiner to note the guidance of M.P.E.P. § 2143, entitled "Basic Requirements of a *Prima Facie* Case of Obviousness", which states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In view of this guidance, the Applicant respectfully traverses the Examiner's conclusion as failing to establish a *prima facie* case of obviousness because the Examiner's cited combination of Suzuki '195, Suzuki '192, and Trail does not provide a basis for combining the references nor does the cited combination teach or suggest all the claim limitations. Specifically, the Applicant respectfully suggests that a skilled artisan would not be motivated to combine the tape analysis unit of Trail with the two Suzuki references to provide a "means to analyze the microspheres" and that the resulting combination teaches an analytic tool means to "operate the machine via a computer control system for collection and review of the data to determine optimal processing conditions."

The Examiner asserts that Trail "teaches that it is well known to use an analytical tool such as a photometer which can be used for analyzing particles and submitting the data to a central computer system for data analysis and processing." Contrary to the Examiner's assertion, however, Trail teaches an apparatus that analyzes defects such as gels and voids in a polymer tape (not microspheres) produced by a tape forming machine **15** onto a take-up reel **42**. The

"take-up reel **42** is transferred to the tape analysis unit and becomes supply reel **42** for the tape analysis unit **25**. The tape analysis unit **25** and the associated sensitive optical and electrical equipment to which take-up reel **42** is transferred should preferably be used in a clean environment in the absence of significant amounts of dust and heat." (See Column 5, lines 13-19 of Trail). Accordingly, Trail teaches an analysis unit that prefers to avoid the presence of small particles, such as dust, for its ideal analysis of tape defects.

Further, Trail teaches "[t]he skilled artisan will recognize that gel fluorescence images, rotated polarized light, and ordinary visible light may be captured by electronic or photographic camera means or a suitable sensor means, such as a photometer. An integrating photometer, which sums the total for the images captured, can be used where gross information on the total defect area is desired and it is not necessary to provide an analysis of the size range and distribution of defects such as gels or black specs." (See Column 6, lines 42-51 of Trail). Given this language, the Applicant respectfully suggests that the cited art of Trail actually teaches not to use an integrating photometer if analysis of gels or black specs, i.e. small particles or "microspheres", is of interest. The Examiner's comment regarding the teachings of Miyazawa is to no avail in view of Trail teaching away from the use of photometers.

Moreover, even assuming *arguendo* that the cited combination provides a motivation to combine the tape analysis unit of Trail to the combination of the two Suzuki references, the cited combination still does not teach or suggest all of the limitations as given in claims 1-8 and 24-25. As noted previously, Trail teaches a tape analysis unit wherein the take-up reel **42** *becomes* the supply reel **42**. A skilled artisan would readily recognize that the take-up reel becomes a supply reel only by removing the reel from one completed process (the tape forming process of FIG. 1 of Trail) and transferring it to begin the second part of a process (the tape analysis process of FIGS. 1 and 5). Given this two-step procedure, a skilled artisan would recognize, contrary to the Examiner's assertion, that the tape analysis unit of Trail teaches a computer system for the collection and review of data while the *analysis of the tape* is in progress, but it does not teach or suggest control or operation of the tape production machine. In view of this recognition, the Applicant respectfully suggests that the Examiner's conclusion (that it would have been obvious to modify the teachings of Suzuki '195 and Suzuki '192 with that of Trail "to incorporate an analytic tool means to analyze the microspheres which are generally made of polymeric material in order to ensure quality and quantity production of the polymeric pellets as well as to operate

the machine via a computer control system for collection and review of the data to determine optimal processing conditions") is unfounded by the cited combination of art. Accordingly, the Examiner's cited combination fails to teach or suggest the limitations of claims 1-8 and 24-25.

CONCLUSION

In view of the above Response, the Applicant submits that all pending claims in the instant application are in condition for allowance over the art cited by the Examiner. The Applicant respectfully requests an early action to this end.

Respectfully submitted,

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/Kurt G. Hammerle/

Kurt G. Hammerle
Registration No. 36,819
NASA Johnson Space Center
Mail Code AL
Houston, TX 77058
281-483-1001 (voice)
281-483-6936 (facsimile)
Customer No. 24957